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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,612	12/05/2001	Geoffrey Hamilton White	PAT-1412	6605

7590
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06/19/2003

EXAMINER

THALER, MICHAEL H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 06/19/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

ee

Office Action Summary

Application No.
10/010,612

Applicant(s)
Geoffrey et al.

Examiner
Michael Thaler

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3731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 23, 2003
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-22 is/are pending in the application.
- 4a) Of the above, claim(s) 1-12, 14, 17, 20, and 21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 16 is/are allowed.
- 6) ☒ Claim(s) 18, 19, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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Newly submitted claims 1-12, 14, 17, 20 and 21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally presented claims were limited to the species in which the connecting members are straight when the stent is in the compressed state (figures 12-17). Newly submitted claims 1-12, 14, 17, 20 and 21 (i.e. claim 1 as now amended) are directed to a patentably distinct species in which the connecting members are curved when the stent is in the compressed state (figures 3-11). Claim 1, as now amended, includes the limitation that the connecting member is connected to adjacent annular elements at two separate locations that are along the same horizontal line of the stent when the stent is in the compressed state. This feature is found in the species of figures 3-9 rather than the species of figures 12-17. Claim 20 includes the limitation that the connecting member is curved when the annular members are in the compressed state. This feature is found in the species of figures 3-11 rather than the species of figures 12-17. Claim 21 includes the limitation that the apices of adjacent annular elements are aligned when the annular elements are in the expanded state. This feature is not found in the species of figures 12-17.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-12, 14, 17, 20 and 21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 18, line 11, "each apex of each annular element is attached to a connecting member" (underlining added) is confusing and inaccurate since the apices at the extreme ends of the stent are not attached to a connecting member.

Claims 18 and 19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roubin et al. ⁵⁸²⁷³²¹ (6,348,065). Roubin et al. show a plurality of annular elements, each annular element having a plurality of alternating struts 42, 44 and apices 46 wherein each annular element has a longitudinal dimension which is smaller in the expanded state than in the compressed state, and a plurality of connector members 84, 86 (figure 8) connecting the apices 46 of adjacent annular elements, each

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connecting member (each of 84 and 86) having a longitudinal dimension which is larger in the expanded state than in the compressed state since the angle between it and the longitudinal axis of the stent decreases as the stent expands, the connecting member (each of 84 and 86) being straight (col. 6, lines 47-50), wherein each apex of each annular element (except at the ends of the stent) is attached to a connecting member (col. 5, lines 42-43). Alternatively, it would have been obvious that each connecting member (each of 84 and 86) has a longitudinal dimension which is larger in the expanded state than in the compressed state since the angle between it and the longitudinal axis of the stent decreases as the stent expands. As to claim 19, the length of the Roubin et al. stent is the same in both the expanded and compressed states since Roubin et al. indicates that the length of the Roubin et al. stent is substantially the same both the expanded and compressed states (col. 5, lines 1-4).

Claim 22 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brown et al. (6,348,065). Brown et al. show a plurality of annular elements 16, wherein each annular element inherently has a longitudinal dimension which is smaller in the expanded state than in the compressed state (since struts 18 extend parallel to the longitudinal axis in

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the compressed state and extend diagonally in the expanded state), and connector member 20 which is straight when the annular elements are in the expanded state (as seen in figure 3). Connector member 20 inherently has a longitudinal dimension which is larger in the expanded state than in the compressed state since the angle between it and the longitudinal axis of the stent decreases as adjacent end portions 19 between elements 16 are circumferentially displaced from each other during stent expansion as described in col. 3, lines 36-39. In other words, during stent expansion, the rotation of one element 16 relative to an adjacent element 16 about the longitudinal axis results in connector member 20 becoming closer to parallel to the longitudinal axis. Note that in figure 1, the angle of connector member 20 is such that one element 16 is directly opposite another. In figure 3, after stent expansion, the angle of connector member 20 is such that the same element 16 that was directly opposite the other is now circumferentially displaced therefrom. Alternatively, connector member 20 obviously has a longitudinal dimension which is larger in the expanded state than in the compressed state for the reasons set forth above. The entire length of the stent experiences a helical twist since each element 16 sequentially rotates

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relative to its adjacent element 16 about the longitudinal axis as indicated in col. 3, lines 36-39.

Claims 15 and 16 are allowed.

Applicant's arguments filed May 23, 2003 have been fully considered but they are not persuasive for the reasons set forth above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
June 11, 2003



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731